

Application No. 10/734,671
Amendment dated April 8, 2010
Reply to Office Action dated January 8, 2010

REMARKS

**Reconsideration And Allowance
Are Respectfully Requested.**

Claim 49-52 are currently pending. Claims 1-48 have been canceled by way of prior amendments. Claim 49 has been amended. No new matter has been added. No new claims have been added. Reconsideration is respectfully requested.

With regard to the objection to claim 49, the claim has been amended as suggested by the Examiner and as such it is requested the objection be withdrawn.

With regard to the assertion of constructive election as presented in the outstanding Office Action, it appears to be misplaced and Applicants request that claims 51 and 52 be properly addressed. The Examiner has improperly read the specification and there has not been a constructive election as suggested by the Examiner. The disclosure on page 22, line 20 - page 23, line 9 applies to all of the markers disclosed and not just the woven marker of Figure 20. That is, all embodiments of the markers disclosed in this section of the specification can be either permanent or bioabsorbable. Although Applicant has constructively elected the species shown in Figure 19, this species may be either permanent or bioabsorbable.

Claims 49 and 50 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,741,198 to Burton (“Burton”). This rejection is respectfully traversed.

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“Anticipation requires that each and every element of the claimed invention is described in a single reference”. *AKZO N.V. v. United States Int'l. Trade Comm'n*, 808 F.2d 1471, 1479 (Fed. Cir. 1986). Although claims during examination are given their broadest reasonable interpretation in order to facilitate precision in claiming, that interpretation must be “consistent with the specification, [and] claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art”. *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990); see also *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (“[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question.”); and *In re Gary Edward Wheeler*, Case No. 2008-1215 (CAFC 2008 (nonprecedential opinion)). Considering the Examiner’s interpretation of Burton as it applies to the pending claims, it is Applicants’ opinion the Examiner has gone well beyond the broadest reasonable interpretation. When construing claims, the claims and the rest of the patent, along with the patent’s prosecution history (together, the intrinsic evidence of the meaning of the claims) are the primary resources; while helpful, extrinsic sources like dictionaries and expert testimony cannot overcome more persuasive intrinsic evidence. See Phillips v. AWH Corp., 415 Fed 3rd at 1318.

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Considering whether the Examiner has properly interpreted the language of the claims and then whether the properly defined terms have been applied to the pending claims in accordance with the patent laws, Applicants respectfully believe the Examiner has erred. The Examiner has improperly interpreted the term “biopsy site”. The Examiner has interpreted this term without reference to the fact the precursor to a “biopsy site” is the performance of a biopsy. That is, and as used in the present claims in a manner understood by one of ordinary skill in the art, in order to have a biopsy site you first need to perform a biopsy. “Biopsy” is a well defined and understood term in the medical field and it is beyond a reasonable interpretation to suggest that a spinal column is a biopsy site.

Burton simply does not explicitly or inherently disclose all of the structural limitations claimed. Claim 49 requires a plurality of small radiodense markers deployed as a biopsy marker material and disposed within the inner lumen. This structural limitation is not disclosed by Burton. Burton can't possibly disclose biopsy marker material since no biopsy is taking place in Burton. A biopsy requires the removal of tissue and a biopsy marker is used to mark the area from which the tissue is taken, such that the area can be relocated if needed. Without a biopsy there can be no biopsy site or biopsy marker.

The ferrofluid of Burton does not mark a desired biopsy site for locating the biopsy site during a future examination as required by the claims. Thus, and as previously stated in the response to the last Office Action, the ferrofluid of Burton is not a marker material as

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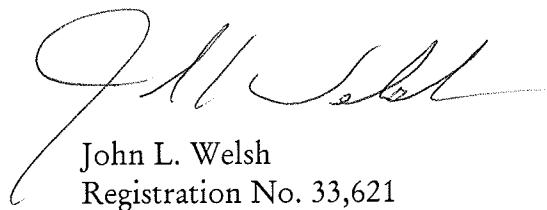
contemplated, disclosed and claimed by Applicants. As such, the rejection based upon Burton is deemed to be improper.

Burton discloses a radiopaque ferrofluid, which is injected to increase the radiopaqueness of body systems where there is slow flow of fluids, to permit radiological examinations by creating a contrast during X-ray procedures. In particular, the ferrofluid of Burton is injected into the spinal column and then is moved up and down the spinal column via a magnetic force to desired areas along the spinal column while taking radiographic images of the desired areas. A highly important aspect of Burton is that once the radiographic examination is completed, the ferrofluid is removed. The ability to completely remove the ferrofluid, thereby avoiding patient discomfort, is Burton's advancement over the prior art. As such, it is evident the ferrofluid of Burton is not used to mark a desired site for locating a biopsy site during a future examination and thus does not function as a marker as claimed. With the forgoing in mind, Burton fails to disclose each and every limitation of claim 49 and thus is improperly relied upon in creating a § 102 rejection.

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It is believed that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested. If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact Applicants' representative at the below number.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. L. Welsh".

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